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Koichi Kawana

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/929,780

Applicant(s)

KAWANA ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 7/23/2007. Claims 1-4, 6-12, 14-18 are pending. Claims 1-4, 6-12, 14-16 are amended. Claims 5, 13 are canceled. Claims 17, 18 are new.

Response to Arguments

1. Applicant's arguments regarding claims 1 and 9, filed 7/23/2007, have been fully considered, but they are not persuasive.

Regarding claims 1 and 9, the applicant argues that Ellis et al. fails to teach or suggest that the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement and, when the acknowledgement is confirmed, playback is ready to begin. The examiner respectfully disagrees. Ellis et al. discloses allowing a user to remotely access video and audio stored on a secondary storage device 32 at user television equipment 22 (p. 12, paragraph 133). The examiner notes that, in order to perform this function, a signal must be sent from the set-top box to the secondary storage device to retrieve the video and audio content, because the communications device is external to the secondary storage device (Figs. 3, 4). The examiner interprets this as the set-top box preparing for playing in accordance with the designation and transmitting an acknowledgement to the secondary storage device, wherein, when the video is retrieved from the secondary storage device and ready to be sent to the remote device (acknowledgement is confirmed), playback is ready to begin. Thus, the examiner

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maintains that Ellis et al. meets the limitation of “wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement, and wherein, when the acknowledgement is confirmed, playback is ready to begin,” as currently claimed.

Ellis et al. further discloses remotely obtaining video or audio from an interactive program guide implemented on interactive program guide equipment over a remote access link in response to the user selecting video or audio for remote playing (Fig. 21). The examiner interprets this as “the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement,” as currently claimed. Ellis et al. still further discloses that the video or audio is played remotely for the user after the video or audio has been remotely obtained (Fig. 21). The examiner interprets this as “when the acknowledgement is confirmed, playback is ready to begin,” as currently claimed. Thus, the examiner maintains that this also meets the limitation of “wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement, and wherein, when the acknowledgement is confirmed, playback is ready to begin,” as currently claimed.

The examiner further notes that many of the transmission schemes Ellis et al. lists as possible for remote access link 19 inherently transfer acknowledgement and confirmation packets prior to transmission of requested data (p. 7, paragraphs 94, 95). For example, Ethernet and TCP/IP provide for transmitting ACK packets acknowledging reception of data transmission and NACK packets requesting re-transmission of packets. This also meets the limitation of “wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement, and wherein, when the acknowledgement is confirmed, playback is ready to begin,” as currently claimed.

Claim Objections

1. Claims **9-16** are objected to because of the following informalities:

Referring to claim **9**, the examiner notes that the phrases “the apparatus,” and “the selection information” lack antecedent basis. The examiner recommends that the phrases be changed to “an apparatus” and “the command,” respectively. The examiner interprets the claim in the Office Action below as though the recommended changes have been made.

Claims **10-16** are objected to as being dependent on claim **9**.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-6, 8-12, 14, 16, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. in view of Gaucher.

Referring to claims **1, 2, 4, 6, and 17**, Ellis et al. discloses a program recording and playing apparatus/method, comprising:

- program management means for managing a database that stores program information for programs (p. 4, 5, paragraphs 69, 70);

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- transmission means for transmitting the program information stored in the database to an electronic apparatus using wireless communication (p. 5, paragraphs 71, 74; p. 6, paragraph 86; & Figs. 3, 4);
- control means for controlling, recording and playing programs in accordance with received selection information (p. 2, paragraph 15; p. 11, paragraph 127; & p. 12, paragraphs 133, 134); and
- determination means for determining whether the selection information indicates information that has been recorded previously by the apparatus having functions of recording and playing programs and for designating a point for which to begin playback when the determination means determines the information has been recorded previously as a function of the selection information (the examiner notes that the user can select a stored program for playback using remote program guide access device 24. The remote program guide access device 24 issues an appropriate access communication to the interactive television program guide to play back the selection and to transmit it to remote program guide access device over remote access link 19)(p. 2, paragraph 15; p. 12, paragraphs 133, 134; & p. 16, paragraphs 168-170), wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement 2240, and wherein when the acknowledgement is confirmed 2250, playback is ready to begin (p. 2, paragraph 133 & Figs. 3, 4, 21).

Ellis et al. further discloses that the remote access link 19 is a wireless cellular link or an infrared link (p. 5, paragraph 77; p. 6, paragraph 86; & p. 7, paragraphs 90, 93, 94). Ellis et al. still further discloses that the remote program guide access device 24 is a personal digital assistant

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(PDA)(p. 7, paragraph 92). Ellis et al. does not disclose a switching means for switching a wireless communication unit between communication using a public circuit based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication system. Gaucher discloses a local wireless network (col. 2, l. 34-36). A cellular phone PDA device controls a VCR to record a particular program through a master computer of the local wireless network if within a specific range. If out of range, the PDA device accesses the master computer and VCR through a cellular modem (col. 3, l. 32-43 & col. 6, l. 34-47, 60-63). The PDA communicates with the master computer and VCR through high power spread spectrum communications (col. 3, l. 60-61; col. 6, l. 1-17; & col. 10, l. 38-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the communication between the remote program access device and local interactive television program guide of Ellis et al. to include switching between a cellular network and a local spread spectrum network depending on a remote access device's location, such as that taught by Gaucher in order to provide a more cost-efficient device.

Referring to claims 3 and 11, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 2 and 10, respectively, wherein said portable terminal comprises a private apparatus (Since the remote program access device 24 communicates with a particular user's set-top box (see citations noted with respect to claim 1), the examiner interprets the remote program access device to be a private apparatus).

Referring to claims 8 and 16, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 6 and 14,

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respectively, wherein the short-distance wireless communication is based on an infrared data communication system (Ellis et al. p. 6, paragraph 86 & p. 7, paragraphs 90, 93).

Referring to claims 9, 10, 12, 14, and 18, Ellis et al. discloses a portable terminal/method for recording and playing programs, comprising:

- transmission means for transmitting program information stored in a database that stores the program information for programs to an electronic apparatus using wireless communication (p. 5, paragraphs 71, 74; p. 6, paragraph 86; & Figs. 3, 4);
- display means for displaying the program information obtained using said transmission means (p. 7, paragraph 92; p. 8, paragraph 102; & Fig. 5);
- command transmission means for transmitting a command that controls recording and playing programs to a server that controls recording and playing performed by an apparatus (p. 2, paragraph 15; p. 6, paragraph 86; p. 11, paragraph 127; & p. 12, paragraphs 133, 134); and
- determination means for determining whether the command indicates information that has been recorded previously by the apparatus having functions of recording and playing programs and for designating a point for which to begin playback when the determination means determines the information has been recorded as a function of the command (the examiner notes that the user can select a stored program for playback using remote program guide access device 24. The remote program guide access device 24 issues an appropriate access communication to the interactive television program guide to play back the selection and to transmit it to remote program guide access device over remote access link 19)(p. 2, paragraph 15; p. 12,

paragraphs 133, 134; & p. 16, paragraphs 168-170), wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement 2240, and wherein, when the acknowledgement is confirmed 2250, playback is ready to begin (p. 2, paragraph 133 & Figs. 3, 4, 21).

Ellis et al. further discloses that the remote access link 19 is a wireless cellular link or an infrared link (p. 5, paragraph 77; p. 6, paragraph 86; & p. 7, paragraphs 90, 93, 94). Ellis et al. still further discloses that the remote program guide access device 24 is a personal digital assistant (PDA)(p. 7, paragraph 92). Ellis et al. does not disclose a switching means for switching a wireless communication unit between communication using a public circuit based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication system. Gaucher discloses a local wireless network (col. 2, l. 34-36). A cellular phone PDA device controls a VCR to record a particular program through a master computer of the local wireless network if within a specific range. If out of range, the PDA device accesses the master computer and VCR through a cellular modem (col. 3, l. 32-43 & col. 6, l. 34-47, 60-63). The PDA communicates with the master computer and VCR through high power spread spectrum communications (col. 3, l. 60-61; col. 6, l. 1-17; & col. 10, l. 38-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the communication between the remote program access device and local interactive television program guide of Ellis et al. to include switching between a cellular network and a local spread spectrum network depending on a remote access device's location, such as that taught by Gaucher in order to provide a more cost-efficient device.

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3. Claims 7, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. in view of Gaucher and further in view of Clapper.

Referring to claims 7 and 15, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 6 and 14, respectively. The combination of Ellis et al. and Gaucher does not teach that the short-distance wireless communication be based on the Bluetooth system. Clapper discloses controlling a set-top box with a remote control unit using a Bluetooth protocol (col. 2, l. 16-32). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the remote program access device in the combination of Ellis et al. and Gaucher to include communicating with the set-top box over a Bluetooth protocol, such as that taught by Clapper in order to provide a simple and accessible protocol for communicating between devices.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600